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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/098, 205 07/27/98 EGGERS

P A-2-2

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QM12/0229

EXAMINER

COHEN, L

ART UNIT	PAPER NUMBER
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3739

DATE MAILED:

02/29/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

<b>Office Action Summary</b>	Application No. <b>09/098,205</b>	Applicant(s) <b>Eggers et al</b>
	Examiner <b>Lee S. Cohen</b>	Group Art Unit <b>3739</b>

Responsive to communication(s) filed on Jan 31, 2000

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 80, 81, and 83-159 is/are pending in the application.

Of the above, claim(s) 103-137 is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 80, 81, 83-85, 87-102, and 138-159 is/are rejected.

Claim(s) 86 is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Claims 103-137 stand withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to a non-elected invention. Election was made **without** traverse in Paper No. 6.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 90-92, 102, and 138-159 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 90 - "the probe" in line 3 lacks antecedent basis. Claim 102 - "the electrically conducting fluid" lacks antecedent basis. Claim 138 - "the electrode terminal" in lines 7 and 8 lacks antecedent basis. Claims 141, 143, 144, 146-148, 150-152, and 157-159 - "the electrode terminal" lacks antecedent basis. Claim 159 -the probe and its recited elements lack antecedent basis.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

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Claims 80, 81, 83-85, 89, 90, 92, 98-100, 138-143, 148, 150, and 156-158 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Roos (4,116,198). The device includes a spaced return electrode as shown by Figure 1. A washing fluid passes through the axial lumen of the device. Since the return electrode is removed from the body structure, a conductive fluid must complete the current flow path.

Claims 80, 81, 83-85, 87, 89, 90, 92, 94-96, 98-102, 138-143, 145, 147, 148, 150, 152-154, and 156-159 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Mulier et al (5,609,151). Applicant's attention is directed to embodiment disclosed in Figures 3 and 4 as detailed at column 6, lines 17-59. Electrodes 202 and 216 may be used in conjunction with one another which would space the ring electrode 216 from the electrode terminal 202.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 87 and 145 are rejected under 35 U.S.C. 103(a) as being unpatentable Roos in view of Mulier et al (5,609,151). The particular fluid for similar methodology is taught by Mulier et al. Accordingly, it would have been within the level of skill of the artisan to select isotonic saline to optimize performing the treatment.

Claims 88, 93, 146, and 151 are rejected under 35 U.S.C. 103(a) as being unpatentable Roos/Mulier et al in view of Baker (5,514,130). Controlling current flow based upon impedance

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or temperature is taught by Baker. Accordingly, it would have been within the level of skill of the artisan to control the current to optimize performing the treatment in light of this teaching.

Claims 91 and 149 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roos or Mulier et al. The particular voltage would have been within the level of skill of the artisan to select to optimize performing the treatment.

Claims 97 and 155 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roos or Mulier et al. The particular material would have been within the level of skill of the artisan to select to optimize performing the treatment.

Claim 86 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 144 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication should be directed to Lee S. Cohen at telephone number (703) 308-2998.



Lee Cohen  
Primary Examiner